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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,958	12/10/2003	Takashi Igarashi	KON-1843	6771
20311	7590	12/06/2006	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				PANNALA, SATHYANARAYA R
ART UNIT		PAPER NUMBER		
				2164

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/731,958	IGARASHI ET AL.	
	Examiner	Art Unit	
	Sathyanarayan Pannala	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/6/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Applicant's Amendment filed on 9/6/2006 has been entered with newly added claims 8-21 and cancelled claims 1-7. In this Office Action, claims 8-21 are pending.

Specification

2. The amendment filed on 9/6/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: Applicant want add the specification consisting of 5 pages as stated in the amendment and the contents are on pages 2-6.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 8-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite,

failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8-14 are rejected under 35 U.S.C. § 101, because claims are directed to program per se. Independent claim 8 is claiming a computer program per se and functional descriptive material consisting of data structures and computer programs, which impart functionality when employed as a computer component. As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 8-10 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Yaegashi et al. (US Patent 6,577,807) hereinafter Yaegashi.

9. As per independent claims 8 and 15, Yaegashi teaches a method producing a tree structure of images for a program even if the moving pictures to be edited are not stored in an information storage unit (col. 1, lines 63-67). Yaegashi teaches the claimed, reading a data set recorded in a recording medium as an additional data set to be added in the recording section (Fig. 2, col. 5, lines 19-23). Yaegashi teaches the claimed, analyzing a data control structure of the additional data set read in the reading step and comparing the analyzed data control structure of the additional data set with a data control structure of a data set stored in a hierarchical position in the hierarchical structure at where the additional data set is linked (Fig. 2, 9-11,13A, col. 4, lines 10-15; col. 12, lines 4-24). Yaegashi teaches the claimed, adding the additional data set to rewrite the hierarchical structure by adding the additional data set linking the additional data at the hierarchical position in the hierarchical structure, when the comparison result of the analyzed data control structure indicates that the data control structure of the additional data set is the same as the data control structure of the data set stored in the recording section (Fig. 2, col. 5, lines 1-43).

10. As per dependent claims 9 and 16, Yaegashi teaches the claimed, the adding step comprises judging that the data control structure of the additional data set is the same as the data control structure of the data set stored in the recording section and adding the additional data set in the recording section, when the data control structure of the stored data set includes a first folder and a second folder located lower than the first folder in the hierarchical structure, and the comparison results indicates that the data control structure of the additional data set also includes the first folder and the second folder (Fig. 9, col. 11, lines 51-67).

11. As per dependent claims 10 and 17, Yaegashi teaches the claimed, the adding step includes linking the additional data set at the hierarchical position lower than the stored data set in the hierarchical structure (Fig. 11, col. 5, line 57 to col. 6, line 9).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 11-14 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaegashi et al. (US Patent 6,577,807) hereinafter Yaegashi, and in view of Ohmura et al. (USPA Pub. 2002/0145633 A1) hereinafter Ohmura.

14. As per dependent claims 11, and 18, Yaegashi does not teach dealing with folders. However, Ohmura teaches the claimed, the adding step includes adding an additional folder indicating an adding position at the same position of the second folder of the stored data set and linking the additional data set at a position lower than the additional folder (Fig. 28, page 11, paragraph [0153]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).

15. As per dependent claims 12, and 19, Yaegashi does not teach dealing with folders. However, Ohmura teaches the claimed, judging that the data control structure

of the additional data set is the same as the data control structure of the data set stored in the recording section and adding the additional data set in the recording section, when the data control structure of the stored data set includes a first folder of a first name and a second folder of a second name located lower than the first folder in the hierarchical structure, and the comparison results indicates that the data control structure of the additional data set also includes the first folder of the first name and the second folder of the second name (Fig. 28, page 11, paragraph [0153]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).

16. As per dependent claims 13 and 20, Ohmura teaches the claimed, when reading a data set recorded in the recording medium as the additional data, renaming the name of a folder of the additional data set (Fig. 23, page 11, paragraph [0148]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).

17. As per dependent claims 14 and 21, Ohmura teaches the claimed, the first folder indicates a storing position of the image data and the second folder indicates a data storing directory (Fig. 16-21, page 11, paragraph [0157]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).

Response to Arguments

18. Applicant's arguments filed 9/6/2006 have been fully considered but they are not persuasive and details as follows:

- a) Applicant's argument stated as "it does not analyze the data structure of the stored data."

In response to Applicants argument, Examiner respectfully disagrees because Yaegashi's teaches analyzing part teaches as comparing adjacent frame images of the frame images constituting the moving pictures and deciding that when image information as the difference between the frame images changes to exceed a predetermined amount the adjacent images belong to a different cut image, see at Fig. 2, col. 4, lines 10-15. Further, in response to applicant's argument that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior

art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sathyanarayanan Pannala
Sathyanarayanan Pannala
Primary Examiner

srp
December 3, 2006